

REMARKS

Claims 1-8 are pending in this application. Claims 1-6 are amended herein. Claims 7 and 8 are added herein. Support for the amendments to the claims, as well as for the new claim, may be found in the claims as originally filed. Reconsideration is requested based on the foregoing amendment and the following remarks.

Objections to the Specification:

The Specification has been objected to for various informalities. Appropriate corrections were made. Withdrawal of the objection is earnestly solicited.

Objections to the Claims:

Claims 1, 3, 4, and 6 were objected to for various informalities. Claims 1, 3, 4, and 6 were amended in substantial accord with the Examiner's suggestions. The Examiner's suggestions are appreciated. Withdrawal of the objection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 112:

Claims 1-6 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claims 1-6 were amended in substantial accord with the Examiner's suggestions. The Examiner's suggestions are appreciated. Withdrawal of the rejection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US Published Application No. 2002/0016824 to Leeds (hereinafter "Leeds") in view of US Patent No. 6,898,715 to Smithson et al., (hereinafter "Smithson"). The rejection is traversed. Reconsideration is earnestly solicited.

Claims 1 and 4 recite:

Mail virus detection.

Neither Leeds nor Smithson teach, disclose, or suggest, "mail virus detection," as recited in recited in claims 1 and 4. Leeds, rather, directs his attention toward preventing delivery of unwanted emails, i.e. spam, as acknowledged graciously in the second paragraph at page 5 of the Office Action. The Office Action seeks to compensate for this deficiency of Leeds by combining Leeds with Smithson, saying, in the last paragraph at page 5:

In light of the above, it would have been obvious to one of ordinary skill in the art

at the time the applicant's invention was made to have modified Leeds' invention according to the limitations recited in claims 1 and 4. One of ordinary skill would have been motivated to do so as it would allow Leeds' invention to better prevent spread of spam messages generated by computer viruses.

Smithson, however, describes no "mail virus detection" either, and thus cannot make up for the deficiencies of Leeds with respect to either claim 1 or claim 4. Smithson, rather, deals with the anti-virus counter-measures to be invoked *after* a computer virus outbreak has been detected, not the detection of the virus itself. In particular, as described in the Abstract of Smithson:

When a computer virus outbreak is detected, a predefined sequence of steps are automatically or manually followed using rule definitions, that may include office hours, to invoke anti-virus counter-measures. The counter-measures can include reducing virus notification, increasing scanning options, blocking E-mail attachments, hiding E-mail address books and the like. The predetermined sequence of actions may be varied with the time of day and day of week.

Since Smithson deals with the anti-virus counter-measures to be invoked after a computer virus outbreak has been detected, not the detection of the virus itself, Smithson cannot compensate for the deficiencies of Leeds with respect to either claim 1 or claim 4. Thus, even if Leeds and Smithson were combined, as proposed in the Office Action, the claimed invention would not result.

It is submitted, furthermore, that persons of ordinary skill in the art who read Leeds for all it contained at the time the invention was made would not have been motivated to modify Leeds as proposed by the Office Action, since Leeds, as acknowledged graciously by the Office Action in the second paragraph at page 5, deals with *unwanted*, or spam, email. Emails carrying viruses, on the other hand, operate by masquerading as *wanted* emails that originate, for example, from senders who are familiar to the recipient.

Furthermore, the references to virus emails and spam emails being "known in the art" in the second paragraph at page 5 of the Office Action appear to border on a taking of Official Notice, in which case the Applicants respectfully traverse the Official Notice and demand authority for the statements. The Applicants specifically points out the following errors in the Office Action.

First, the Office Action uses common knowledge as the principal evidence for the rejection. As explained in M.P.E.P. § 2144.03(E):

Any facts so noticed should . . . serve only to 'fill in the gaps' in an insubstantial manner which might exist in the evidentiary showing made by the Examiner to support a particular ground of rejection. It is never appropriate to rely solely on common knowledge in the art without evidentiary support in the record as the

principal evidence upon which a rejection was based.

Second, the noticed fact is not considered to be common knowledge or well known in the art. In this case, the limitation is not of notorious character or capable of instant and unquestionable demonstration as being well-known. Instead, this limitation is unique to the present invention. See M.P.E.P. § 2144.03(A) ("the notice of facts beyond the record which may be taken by the Examiner must be "capable of such instant and unquestionable demonstration as to defy dispute").

Third, there is no evidence supporting the assertion. See M.P.E.P. § 2144.03(B) ("there must be some form of evidence in the record to support an assertion of common knowledge").

Fourth, it appears that the rejection is based, at least in part, on personal knowledge. 37 C.F.R. § 1.104(d)(2) requires such an assertion to be supported with an affidavit when called for by the Applicant. Thus, Applicants call for support for the assertion with an affidavit.

Claims 1 and 4 recite further:

Suppressing sending other electronic mail, the electronic mail including the mail virus information.

Neither Leeds nor Smithson teach, disclose, or suggest, "suppressing sending other electronic mail, the electronic mail including the mail virus information," as recited in claims 1 and 4. Leeds, as discussed above, directs his attention toward preventing delivery, i.e. receipt of unwanted emails, i.e. spam, as acknowledged graciously in the second paragraph at page 5 of the Office Action. Unwanted emails like spam do not generally replicate themselves like viruses, and send themselves to other recipients.

Furthermore, Leeds does not describe suppressing sending other email of the same type when it is determined that the email indicates the second address, contrary to the assertion in the Office Action in the first paragraph at page 5. Leeds, rather, only *warns* the recipient that the email is thought to be junk, and sends it along anyway. Leeds makes no effort to actually stop delivery of the email, let alone "suppressing sending other electronic mail, the electronic mail including the mail virus information," as recited in claims 1 and 4. In particular, as described in paragraph [0036]:

If the message was determined to be a junk e-mail, the mail program would be informed, and the user would be able to have the message automatically discarded or to be marked as potentially junk.

Since Leeds only warns the recipient that the email is thought to be junk, and sends it along anyway, Leeds is not "suppressing sending other electronic mail, the electronic mail including the

mail virus information," as recited in claims 1 and 4.

Finally, in the case where an email is known to originate from a junk e-mailer, Leeds still only *warns* the mail handling system that the email is thought to be junk, and sends it along anyway. Leeds makes no effort to actually stop delivery of the email, let alone "suppressing sending other electronic mail, the electronic mail including the mail virus information," as recited in claims 1 and 4. In particular, as described in paragraph [0037]:

If the code was for a known junk e-mailer, or if the code and the "From:" field did not match, the mail program or mail handling system would be warned of the problem.

Since Leeds only warns the mail handling system that the email is thought to be junk, and sends it along anyway, Leeds is not "suppressing sending other electronic mail, the electronic mail including the mail virus information," as recited in claims 1 and 4. Thus, even if Leeds and Smithson were combined, as proposed in the Office Action, the claimed invention would not result. Claims 1 and 4 are submitted to be allowable. Withdrawal of the rejection of claims 1 and 4 is earnestly solicited.

Claims 2, 3, 5, and 6 depend from either claim 1 or claim 4 and add further distinguishing elements. Claims 2, 3, 5, and 6 are thus also submitted to be allowable. Withdrawal of the rejection of claims 2, 3, 5, and 6 is earnestly solicited.

New claims:

Claim 7 recites:

Suppressing a transmission of said second piece of electronic mail if said second type is substantially equivalent to said first type and an address of said first piece of electronic mail is an address for mail virus detection.

None of the references cited teach, disclose, or suggest, "suppressing a transmission of said second piece of electronic mail if said second type is substantially equivalent to said first type and an address of said first piece of electronic mail is an address for mail virus detection," as discussed above with respect to the rejections of claims 1 and claim 4. Claim 7 is thus believed to be allowable as well, for at least those reasons discussed above with respect to the rejections of claims 1 and claim 4.

Claim 8:

Claim 8 depends from claim 1 and adds further distinguishing elements. Claim 8 is thus also submitted to be allowable as well.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-8 are allowable over the cited references. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.


If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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